

REMARKS

Applicants thank the Examiner for the thorough consideration given the present application.

The Examiner is requested to approve the change to FIG. 1 so that the packets, formerly bearing the reference numeral 10, bear the reference numeral 13, for consistency with page 2, line 2 of the application as filed and to avoid a duplication of reference numerals, as a result of the tape drive in FIG. 2 bearing the reference numeral "10."

The specification has been amended to improve syntax and to correct clerical errors.

Applicants note the indication that claims 6, 11-14 and 20 contain allowable subject matter and that these claims would be allowed if combined with the claims upon which they depend. To this end, claims 1 and 2, with modifications to assure open-ended coverage, have been combined with claim 6. Modified claims 1 and 2 and claims 10 and 11 have been combined. Modified claims 1 and 2 and claims 10 and 13 have been combined. Modified claims 1 and 2 and claims 7 and 14 have been combined. Modified claims 1 and 2 and claims 15 and 20 have been combined.

In addition, claims 3, 7, 9 and 15 have been amended to depend on allowed claim 10. Claims 1, 2, 7, and 8 have been combined, and claims 1, 2 and 22-29 have been canceled to expedite

prosecution. Claim 30 has been amended to depend on newly added claim 49. Claims 31-51 have been added to provide applicants with the protection to which they are deemed entitled. The basis for newly added claims 31 and 36 appears in the application as filed in the first full paragraph on page 2 of the application as filed. The basis for the remaining claims appears in Figs. 8 and 11 and the descriptions thereof in the application as filed.

Applicants traverse the rejection of claim 8 as being anticipated by Goker et al., U.S. Patent No. 5,675,447. The Office Action alleges that column 15, lines 20-24, of Goker et al. discloses configurable sync bytes. Applicants cannot agree. The relied on portion of Goker et al. states:

The synchronization bytes provide a "fault tolerance synchronization" with a separator byte (training byte) in the middle. The search information will be processed if either one of the two synchronization bytes are recovered.

Thus, there is no mention in this portion of Goker et al. of the synchronization bytes being configurable, and Applicants fail to understand the basis for the Examiner's statement.

If the Examiner is stating that the quoted portion of Goker et al. inherently provides configurable sync bytes, the Examiner has not met the burden of establishing a *prima facie* case of inherency.

The fact that a certain result or characteristic **may** occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981). To establish inherency, extrinsic evidence must make clear that the missing descriptive matter is **necessarily** present in the thing described in the reference and that it would be so recognized by persons of ordinary skill in the art. Inherency may not be established by possibilities or probabilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Roberston*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). In relying upon a theory of inherency, the Examiner must provide a basis in fact or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (B.P.A.I. 1990).

Since the Examiner has not provided a rationale or evidence to show that the quoted portion of Goker et al. inherently provides configurable sync bytes, the rejection of claim 8 based on Goker et al. is incorrect and must be withdrawn.

Newly added claims 31 and 36 indicate that at least one of the synchronization fields is capable of having different bit configurations, i.e., is configurable. In addition, claim 31 defines the active step of changing the bits of the predetermined bit pattern that is used to compare at least one of the read synchronization fields so they are the same as the bits of the at least one synchronization byte which is capable of having different bit configurations.

Claim 36 also includes the step of writing onto a medium plural data items each including user and non-user data, wherein the non-user data includes one or more synchronization fields with plural synchronization bytes, at least one of which is capable of having different bit configurations. The bit configuration of the at least one synchronization byte capable of having a different bit configuration is required to be changed in claim 36. Claim 36 also requires the bits of the predetermined bit pattern that is compared with the synchronization bytes to be changed so they are the same as the bits of the at least one synchronization byte which is capable of having different bit configurations.

Hence, claims 31 and 36, in addition to including the claim 8 requirement for the sync bytes to be configurable, indicate how the configurable sync bytes are processed.

Each of newly added independent claims 37, 43, and 47 is directed to a storage medium. Claim 37 is the most comprehensive of these three independent claims, because claim 37 defines the forward synchronization field, back synchronization field and the resynchronization field. Predetermined patterns of first and second non-user data are respectively positioned on the medium so the first non-user data precedes the forward synchronization field in the direction of the forward reading and the second non-user data is positioned on the medium so the second non-user data follows the back synchronization field in the direction of forward reading.

Claim 43 defines the forward and back synchronization fields and first and second non-user data, without defining the resynchronization field. Claim 47 defines the forward and resynchronization fields and the first non-user data that is positioned so it precedes the forward synchronization field in the direction of forward reading. In addition, claim 47 indicates that one of the plural user data items is positioned on the medium between the forward and resynchronization fields and another of the user data items is positioned on the medium after the resynchronization field in the direction of forward reading.

The foregoing features are clearly not disclosed or made obvious by the art of record.

Claims 49, 50, and 51 are respectively directed to the method of reading from the media of claims 37, 43, and 47. Claims 30, 52, and 53 are directed to a computer program product for enabling a processor to perform the methods of claims 49, 50, and 51, respectively. Claims 54, 55, and 56 are directed to apparatus for performing the methods of claims 49, 50 and 51, respectively.

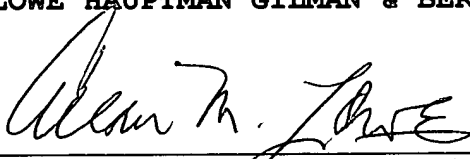
In view of the foregoing amendments and remarks, favorable reconsideration and allowance are respectfully requested and deemed in order.

Pursuant to 37 C.F.R. §1.136(a), Applicants hereby request a one-month extension of time in which to file this paper. Authorization for payment of the \$110 fee is attached. If in error, the Commissioner is hereby authorized to charge any omitted fees, including extension of time fees, to Deposit Account No. 07-1337.

Respectfully submitted,

LOWE HAUPTMAN GILMAN & BERNER, LLP

By:


Allan M. Lowe, Reg. No. 19,641

1700 Diagonal Road, Suite 300
Alexandria, VA 22314
703-684-1111 telephone
703-518-5499 telecopier
AML:gmj:rk